



31 AUG 2006

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In re Application of
MONSE et al.
Application No.: 10/532,263
PCT No.: PCT/EP03/13322
Int. Filing Date: 26 November 2003
Priority Date: 27 November 2002
Attorney Docket No.: 63249(50964)
For: N,N-BRIDGED, NITROGEN-
SUBSTITUTED CARBACYCLIC
INDOLOCARBAZOLES AS PROTEIN KINASE
INHIBITORS

DECISION

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 13 March 2006 in the United States Patent and Trademark Office (USPTO), requesting acceptance of the application without the signature of Hanno Roder. Petitioner's request for a four month extension of time is granted.

BACKGROUND

On 12 April 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 12 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for response. Extensions of time were available under 37 CFR 1.136(a).

On 13 March 2006, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, authorization to charge the petition fee to applicant's deposit account, a first hand statement of facts, a declaration by the joint inventors on behalf of the nonsigning inventor and a request for a four month extension of time (small entity).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

The petition fee of \$200 under 27 CFR 1.17(g) has been paid, satisfying Item (1). Item (3) has been satisfied with the non-signing inventor's last known address.

Item (4) has not been satisfied with the submission of the combined declaration filed 13 March 2006 because the declaration is not in compliance with 37 CFR 1.497(a)-(b). The declaration is comprised of seven pages, containing one Page 1, one Page 2, one Page 3 and one Page 7. However, it also contains three duplicate Page 4 signature pages, three duplicate Page 5 signature pages and two duplicate Page 6 signature pages. Each duplicate page is executed by a different inventor. It appears to be a composite declaration created from the combination of separately executed declarations and is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed. Item (4) remains unsatisfied.

Item (2) has not been satisfied. MPEP § 409.03(d) states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. See MPEP 409.02.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will

not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

(Emphasis added.)

Here, the declaration of Dr. Georg Schnappauf, European patent attorney representing the assignee, was presented in support of the petition under 37 CFR 1.47(a). Dr. Schnappauf states that on 23 January 2006, he sent a copy of the patent application papers to Mr. Roder at his last known address in the United States. The envelope was returned unopened after three delivery attempts. No evidence of this delivery was provided with his declaration. According to Dr. Schnappauf, the attempt to deliver to his last known address in Germany was returned unopened with a note indicating that Mr. Roder no longer resided at that address. No evidence of this delivery was provided with his declaration.

E-mail messages to several email addresses were also returned as undeliverable. On 3 February 2006, Dr. Schnappauf sent a copy of the application papers to Mr. Roder at TauTaTis, Inc., an address found on the internet, which was also unsuccessful. No evidence of this delivery was provided with his declaration. Dr. Schnappauf states that an E-mail to Mr. Roder at TauTaTis, Inc. appeared to be received without response. (A copy of the e-mails were attached to the statement).

The evidence provided is insufficient to demonstrate that Mr. Roder is unavailable. First, Dr. Schnappauf did not provide any evidence of delivery to Mr. Order's last known address in the U.S. It may be that Mr. Order was out of town or unavailable at the time of the delivery (i.e. at work or away from home). Moreover, Dr. Schnappauf did not provide any details regarding his Internet search for Mr. Order's whereabouts. Nor did Dr. Schnappauf provide any details regarding the attempt to deliver the envelope to Mr. Order at TauTaTis, Inc., saying "all attempts to deliver the envelope were unsuccessful." An E-mail from Mr. Order stating "I haven't received anything in that regard. Where was it sent?" does not appear to be a statement of refusal, as Dr. Schnappauf contends. Rather, it is unclear what to Mr. Order is referring, as the E-mail does not identify the PCT application in any way.

Based upon this evidence, it cannot be concluded that Mr. Order refuses to sign the application papers. Thus, in light of the MPEP §409.03(d) instruction regarding an inventor's unavailability to sign, applicant has not established sufficient evidence to conclude that Mr. Order is unavailable to sign. Further details regarding the diligent efforts to contact Mr. Order via mail, telephone and E-mail should be provided by a person with first-hand knowledge. Thus, item (2) has not been met.

Items (2) and (4) have not been satisfied and thus, the petition under 37 CFR 1.47(a) is dismissed without prejudice.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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